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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,153	03/12/2001	Takao Samukawa	1538.1012	3267
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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER MILEF, ELDA G	
			ART UNIT 3628	PAPER NUMBER

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/803,153	<b>Applicant(s)</b> SAMUKAWA ET AL.	
	<b>Examiner</b> Elda Milef	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

***Claim Objections***

2. Claims 2,10,18 recites the limitation "said threshold". There is insufficient antecedent basis for this limitation in the claim.

Claims 3, 11, 19, 21 are objected to because of their dependencies to claims 2, 10, 18.

***Information Disclosure Statement***

3. The information disclosure statement filed August 30, 2005 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. (Japanese Patent Application No. 2001-013934).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 2: The Examiner is confused to the meaning of "threshold value" used in this claim and its relation to the trading fee limitation.

Claim 3 is rejected because of its dependency to rejected claim 2.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-24 rejected under 35 U.S.C. 103(a) as being unpatentable over Wallman (US PAT 6,601,044) in view of Dalton, John M., "How the Stock Market Works". NYIF Corp. 1993. p.107-111.

**Re Claim 1, 9, and 17:** Wallman discloses: A method, storage medium and a system for supporting a trading of an odd lot that is less than a round lot stock number determined in every stock company, said method comprising the steps of: receiving from a customer, an odd lot selling order or an odd lot buying order for a particular stock company (see col 52, lines 22-25);

Wallman does not disclose: judging whether or not a number of total stocks of said odd lot selling orders or a number of total stocks of said odd lot buying orders received at said receiving is over a threshold value that is less than said round lot stock number and is determined by a predetermined rule; and if it is judged at said judging that the number of total stocks of said odd lot selling orders or the number of total stocks of said odd lot buying orders is over said threshold, outputting a selling order of said round lot stock number defined for said particular stock company for said odd lot selling orders or a buying order of said round lot stock

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number defined for said particular stock company for said odd lot buying orders. It is well known in the art that all trades are divided into two basic types according to size, round lots and odd lots as shown by Dalton pgs. 107-111, in particular p. 107, para. 3 ("An odd lot is therefore a trade from one to 99 shares.") and p.109, para. 1-3 ("Odd-lot orders for separate customers may be bunched as long as the consent of each customer is obtained... Like round-lot market orders, odd-lot market orders require execution at the best available price. Because odd-lot orders may not be bid, offered, or used to initiate transactions, they must wait for an effective round-lot execution.") The round lot is the basic unit of trading, is multiples of 100 shares. Odd lots are for less than this amount. Before buying stocks investor has options depending on individual preferences. The individual investor may have plurality of options available to him/her in which to make a choice of making a particular trade. Thus, one of ordinary skill in the art making such a judgment would have been obvious to do when viewing the system of Wallman, thus providing a better control of a particular buy/sell order. Wallman system shows that a customer can buy/sell odd lot orders see col.35 45-67, col. 36, lines 1-31, col. 44 lines 29-32, col.46 lines 5-12 therefore, it would have been obvious to one

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having ordinary skill in the art at the time that the invention was made to combine the teachings of Wallman with what is well known in the art as evidenced by Dalton in order to provide the investor with the benefits of diversification in their portfolios.

**Re Claim 2,10,18:** For purposes of examination, the Examiner is interpreting claims 2, 10, and 18 to mean determining a differential return and relative risk to an investment. Wallman discloses ("A risk and differential return calculation process calculates a risk and a differential return of the entire investor portfolio...and provides the relative risk and differential return to the graphical investor interface, which displays... to the investor.")-see col. 14, 11-59, also see cols. 11,13.

Further, Wallman discloses a portfolio management method that is cost effective. Wallman teaches ("In response to the actual trading pricing information received by a particular investor, the investor program modifies the display of the risk and differential return of the entire investor portfolio in accordance with the actual trading pricing information regarding each asset/liability traded by the investor. Based on this information, the investor program recommends modifications to

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the investor portfolio to the investor via the graphical investor interface to make the investor portfolio match the percentage allocation previously determined if the investor portfolio no longer matches the percentage allocation as a result of the actual trading pricing information received from the processor. ") - see col. 13, lines 19-38; and ("one of the strong advantages of the present invention: namely the number of trades that must be executed externally...if there is netting of buys against sells, i.e., either a single buy or a single sell depending on whether the total number of shares being bought exceeded the total number of shares being sold or vice versa.") - col. 35, line 45 - col. 36, line 30. It is obvious from the teachings of Wallman that a trading fee (differential), is included in the calculation of the return. It is also well known in the art of finance that a differential is a charge commonly added to the purchase price and subtracted from the selling price by the dealer for odd-lot quantities. This fee is disclosed to the investor and is used in the risk/return calculations concerning investments. Investors generally prefer a gain from their investments and as such, the system disclosed by Wallman attempts to do this. Wallman allows for odd-lot as well as round lot trading - see col. 19, lines 61-65.



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**Re claims 3,4,11,12,19, and 20:**

The method, storage medium and a system wherein said risk amount is determined by a limited price range or a price itself. The method, storage medium and a system, wherein said predetermined rule is a rule based on a trading volume of stocks of said particular stock company during a predetermined period ."-see Wallman col. 31, lines 16-18( "the investor is able to select the entire portfolio as defined, and specify the dollar amount to be invested..." ) and ("As an example, an investor might have stated that he wished to invest solely in large capitalization, software, financial services and entertainment companies based in the United States with no negative corporate governance factors. The system then returns a listing of stocks, including obvious ones that are household names and some that are not. The system then specifies percentages of each stock to allocate to the portfolio in order to insure a reasonable level of diversification (and would alert the investor if that could not be done). One example would be dividing the total dollar amount being invested by the number of securities meeting the criteria entered by the investor and allocating an equal dollar amount or a capitalization-weighted dollar amount to each of the securities, and if there were fewer than twenty securities for example, indicating to the investor

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that reasonable levels of diversification were not necessarily achieved. It should be noted that other levels of diversification could be used as well.")-see col. 26, lines 10-27.

**Re Claim 5, 13 and 21:** Wallman does not explicitly teach "The method, storage medium and system, further comprising the steps of: judging whether or not said number of said total stocks of said odd lot buying orders or said number of said total stocks of said odd lot selling orders that are received at said receiving is over said round lot stock number of said particular stock company; if it is judged at said second judging that said number of said total stocks of said odd lot buying orders or said number of said total stocks of said odd lot selling orders is over said round lot stock number, providing a minimum number of ordered stocks of said odd lot buying orders or said odd lot selling orders to each customer who makes said odd lot buying order or said odd lot selling order; and providing a number of remainder stocks that is calculated by subtracting a number of all stocks provided at said first providing from said round lot stock number, to a customer who has a remainder of the order, according to a second predetermined rule."

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The individual investor may have plurality of options available to him/her in which to make a choice of making a particular trade. .- See Dalton, pgs. 107-111, in particular p. 107, para. 3 ("An odd lot is therefore a trade from one to 99 shares.")

Thus, one of ordinary skill in the art making such a judgment would have been obvious to do when viewing the system of Wallman, thus providing a better control of a particular buy/sell order. As per this limitation, in the purchasing/selling of financial securities, there could be a great number of possible ways to set a predetermined rule for providing a minimum number of ordered stocks to each customer and such would not affect the functioning of the system of Wallman. Brokers usually provide the remainder of the stocks to a customer who has the remainder of the order. Thus, one of ordinary skill in the art at the time of the invention would have been motivated to such a rule for determining a minimum number of ordered stocks in the system of Wallman in order to maintain the system of Wallman and also to provide the ordered stocks to customers/investors.

**Re Claim 6, 14 and 22:** Wallman does not explicitly teach "The method, storage medium and system, further comprising:

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judging whether or not said number of said total stocks of said odd lot buying orders or said number of said total stocks of said odd lot selling orders that are received at said receiving is over said round lot stock number of said particular stock company;

if it is judged at said second judging that said number of said total stocks of said odd lot buying orders or said number of said total stocks of said odd lot selling orders is over said round lot stock number, judging whether or not it is possible to provide a minimum number of ordered stocks of said odd lot buying orders or said odd lot selling orders to each customer who makes said odd lot buying order or said odd lot selling order;

if it is judged at said third judging that it is impossible to provide, providing one stock to said each customer; and providing a number of remainder stocks that is calculated by subtracting a number of all stocks provided at said first providing from said round lot stock number, to a customer who has a remainder of the order, according to a second predetermined rule."

As per this limitation, the Examiner asserts that the individual investor may have a plurality of options available to him/her in which to make a choice of making a particular trade.- See

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Dalton, pgs. 107-111, in particular p. 107, para. 3 ("An odd lot is therefore a trade from one to 99 shares.") Thus, one of ordinary skill in the art making such a judgment would have been obvious to do when viewing the system of Wallman, thus providing a better control of a particular buy/sell order.

Furthermore, in the purchasing/selling of financial securities, there could be a great number of possible ways to set a predetermined rule for providing a minimum number of ordered stocks to each customer. A result of such would not affect the functioning of the system of Wallman. A broker desiring to buy/sell round lot would have been motivated to add the remainder of an order (not being a round lot or an odd lot) to be added with a number of an order or odd lot to make a round lot. -See Dalton, pgs. 107-111, in particular\ p. 109 para. 1, ("Odd-lot orders for separate customers may be bunched as long as the consent of each customer is obtained.") Thus, one of ordinary skill in the art at the time of the invention would have been motivated to such a rule for determining a minimum number of ordered stocks in the system of Wallman in order to maintain the system of Wallman and also to transact or buy/sell the desired ordered stocks.

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**Re Claims 7, 15 and 23:** Wallman does not explicitly teach "A method, storage medium and system for supporting a trading of an odd lot that is less than a round lot stock number determined in every stock company, said method comprising:

judging whether or not a number of total stocks of odd lot buying orders or a number of total stocks of odd lot selling orders that are received from customers is over said round lot stock number of said particular stock company;

if it is judged at said judging that said number of said total stocks of said odd lot buying orders or said number of said total stocks of said odd lot selling orders is over said round lot stock number, judging whether or not it is possible to provide a minimum number of ordered stocks of said odd lot buying orders or said odd lot selling orders to each customer who makes said odd lot buying order or said odd lot selling order;

if it is judged at said second judging that it is possible to provide, providing said minimum number of said ordered stocks of said odd lot buying orders or said odd lot selling orders to said each customer who makes said odd lot buying order or said odd lot selling order; and providing a number of remainder stocks that is calculated by subtracting a number of all stocks provided at said first providing from said round lot stock

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number, to a customer who has a remainder of the order, according to a second predetermined rule."

Furthermore, in the purchasing/selling of financial securities, there could be a great number of possible ways to set a predetermined rule for providing a minimum number of ordered stocks to each customer. .- See Dalton, pgs. 107-111, in particular p. 107, para. 3 ("An odd lot is therefore a trade from one to 99 shares.") A result of such would not affect the functioning of the system of Wallman. A broker desiring to buy/sell round lot would have been motivated to add the remainder of an order (not being a round lot or an odd lot) to be added with a number of an order or odd lot to make a round lot. -See Dalton, pgs. 107-111, in particular p. 109 para. 1, ("Odd-lot orders for separate customers may be bunched as long as the consent of each customer is obtained.") Thus, one of ordinary skill in the art at the time of the invention would have been motivated to such a rule for determining a minimum number of ordered stocks in the system of Wallman in order to maintain the system of Wallman and also to transact or buy/sell the desired ordered stocks.

**Re Claim 8, 16 and 24:** Wallman does not explicitly teach "The method, storage medium and system, further comprising:

if it is judged at said second judging that it is impossible to provide, providing one stock to said each customer; and providing a number of remainder stocks that is calculated by subtracting a number of all stocks provided at said first providing from said round lot stock number, to a customer who has a remainder of the order, according to a second predetermined rule."

Furthermore, in the purchasing/selling of financial securities, there could be a great number of possible ways to set a predetermined rule for providing a one stock to each customer. A result of such would not affect the functioning of the system of Wallman. A broker desiring to buy/sell round lot would have been motivated to add the remainder of an order (not being a round lot or an odd lot) to be added with a number of an order or odd lot to make a round lot. Thus, one of ordinary skill in the art at the time of the invention would have been motivated to such a rule for determining a number of remainder stocks in the system of Wallman in order to maintain the system of Wallman and also to transact or buy/sell the desired ordered stocks.

#### ***Response to Arguments***

6. In response to the applicant's suggestion that neither Wallman nor Dalton teach or suggest the use of any threshold



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value in making a judgment regarding odd lot trading. As stated in the office action p. 4 ("It is old and well known in the art that all trades are divided into two basic types according to size, round lots and odd lots"), further Dalton defines odd lot shares as a trade from one to 99 shares. Therefore, it is obvious that a "threshold value" must be set by a trading program in order to classify the trade as either an odd lot trade or a round lot trade. Further, as stated in the office action, Wallman discloses a computer-based system capable of odd lot trading -see col. 35 lines 45-67 and col. 36 lines 1-31, and ("Shares can be bought in very small odd lots(one or two shares), and even in fractions-purchases not possible on a cost effective basis with ordinary brokerage.")-see col. 44 lines 30-31, and ("Once the trades can be aggregated, and netted against one another, leaving only a small number of shares to either be purchased or sold.")-see col. 46 lines 29-32. Therefore, it is obvious that with the odd lot definition disclosed by Dalton combined with the computer based system of Wallman, a threshold value must be present in order for the computer system of Wallman to identify an odd lot trade.

Regarding the applicant's suggestion that neither Wallman nor Dalton teaches providing a minimum number of ordered stocks of said odd lot buying orders or said odd lot selling orders to

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each customer..., the applicant's attention is directed to Dalton p. 107 wherein Dalton teaches ("An odd-lot is therefore a trade from one to 99 shares.") Dalton teaches that a round lot is typically 100 shares, therefore an odd-lot is less than a round lot and must be traded at a minimum of one share. Regarding the applicant's suggestion neither Wallman nor Dalton teach providing a number of remainder stocks that is calculated by subtracting a number of all stocks provided at said first providing from said round lot stock number. The applicant's attention is directed to Dalton pp. 107-111 wherein defines odd-lot trading. An odd-lot is defined as being an amount of stock smaller than the normal trading unit which is typically a round lot or 100 shares. Therefore, it is obvious that the odd-lot could be considered as part of a round lot.

Regarding the applicant's argument suggesting neither Wallman nor Dalton teaches "providing one stock to each customer". The applicant's attention is directed to Dalton p. 107, para. 3-p. 108 wherein Dalton teaches ("specialists also accommodate odd-lot customers by acting as dealers and filling odd-lot orders...Specialists must buy when the customer wants to sell, and sell when a customer wants to buy. And they must do so at the first possible opportunity after receiving the odd-lot

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order.") It is obvious from the teachings of Dalton that a specialist must fill the orders requested by the customer.

Applicant's arguments with respect to claims 2, 10, and 18 have been considered but are moot in view of the new ground(s) of rejection.

### **Conclusion**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

*The New Price Benchmark (Ameritrade Holding's new Freetrade.com online brokerage service lets customers place market orders commission-free).* Financial Service Online, v. 5, n7, p.9, June, 2000.-Cited for its reference to odd-lot orders.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this

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action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elda Milef whose telephone number is (571)272-8124. The examiner can normally be reached on Monday - Friday 9:15 am to 5:45 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (571)272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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